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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/502,264

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Kazuhiro Namba

F-8340

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09/21/2006

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EXAMINER

NGUYEN, KIM T

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/502,264

Applicant(s)

NAMBA ET AL.

Examiner

Kim T. Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/22/04, 11/30/04, 8/21/06</u> .                              | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 11/30/04 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Objections***

2. Claims 2-3, 5-7, 9-10 are objected to because of the following informalities:
- a) In claim 2, line 4; claim 3, lines 3-4; claim 5, line 4; claim 6, lines 3-4; claim 7, line 4; claim 9, line 4; and claim 10, line 4, the claimed limitation "an inhibited act" should be corrected to "the inhibited act".
  - b) In claim 3, line 4; claim 5, line 4; claim 6, line 4; and claim 10, line 5, the claimed limitation "a user" should be corrected to "the user".

- c) In claim 10, line 3, the claimed limitation “means: presents” should be corrected to “means presents”.

Appropriate correction is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "the presenting means" in line 3. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 states "A manipulation suppression program which is used to suppress a predetermined manipulation by a user ... allows a video game machine to function as: a detecting means ..." The claim starts off by reciting a program one statutory class, i.e. a manipulation suppression program. Then the claim states that the

program allows a video game machine to function as a product as second statutory class, i.e. a detecting means, an executing means. Consequently, it is unclear from the claim whether applicant has intended to claim a product, i.e. video game machine, or a program since the claim overlaps two statutory classes. It is unclear as to which statutory class the claim falls into. Therefore, the claim is directed to neither a "process" nor a "machine" but rather embraces or overlaps two different statutory classes of inventions. See MPEP 2 173.05(p).

Claims 2-10 are similarly rejected as explained above.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**8. Claims 1-6 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto et al (US 5,941,774).**

Claims 1-3: Takemoto discloses a manipulation suppression program which is used to suppress a predetermined manipulation by a user. The program allows a video game machine to function as a detection means for detecting a preset inhibited act (col. 23, lines 20-27; col. 24, lines 65-67; and col. 25, lines 1-6). Takemoto does not explicitly disclose an executing means for executing a predetermined operation which

suppresses the inhibited act. However, Takemoto discloses displaying a message to indicate the inhibited act if the inhibited act is detected (col. 25, lines 10-15 and 51-63). Takemoto obviously encompasses an executing means as claimed in order to stop the player from manipulating an inhibit act.

Claims 4-6 and 11-12: refer to discussion in claims 1-3 above.

Claims 9-10: terminating a game forcedly if a predetermined number of inhibited act are detected would have been obvious to a person of ordinary skill in the art at the time the invention was made.

**9. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto et al (US 5,941,774) in view of Harada et al (US 2001/0007825).**

Claims 7-8: Hiroshi discloses including a game situation changing means for changing a game situation by changing a parameter which corresponds to a character in the game of the game situation (paragraphs 0124). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the changing means of Harada to the game machine of Takemoto in order to stop the player from manipulating an inhibited act.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is 571-272-4441. The examiner can normally be reached on Monday-Thursday during business hours.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on 571-272-7147. The central official fax number for the organization where this application or proceeding is assigned is 571-273-8300.

kn  
Date: September 14, 2006

A handwritten signature in black ink, appearing to read 'Kim Nguyen', with a horizontal line extending from the end of the signature.

Kim Nguyen  
Primary Examiner  
Art Unit 3713